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Filing date: **04/01/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048732
Party	Defendant Ronald Beckenfeld
Correspondence Address	MICHAEL L LOVITZ LOVITZ IP LAW PC 9701 WILSHIRE BLVD, STE 1000 BEVERLY HILLS, CA 90212 UNITED STATES mlovitz@lovitziplaw.com
Submission	Reply in Support of Motion
Filer's Name	Michael L. Lovitz
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Date	04/01/2013
Attachments	Reply in Support of Motion to Suspend.pdf (8 pages)(857240 bytes)

ALTVATER GESSLER – J.A.	:	Cancellation 92048732
BACZEWSKI	:	
INTERNATIONAL (USA) INC. and	:	
ALTVATER GESSLER – J.A.	:	
BACZEWSKI GMBH,	:	
	:	
Petitioners,	:	Registration No.: 2,731,948
	:	
v.	:	
	:	
RONALD BECKENFELD,	:	
	:	
Respondent	:	Attorney Docket No. B1001-9001

Respondent, Ronald Beckenfeld, by and through his undersigned counsel, respectfully
replies to Petitioners' Opposition to Respondent's Motion to Suspend, filed on March 25, 2013.

On January 14, 2008, Petitioners filed the instant Petition for Cancellation of Registration No. 2,731,948. Since June 2008, Petitioners conducted extensive discovery in this proceeding, including written discovery and depositions. Declaration of Michael L. Lovitz (“Lovitz Dec.”) at ¶3-5.

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and ask questions concerning the 1992 transfer of the MONOPOLOWA trademark. *Id.* at ¶6, 8. Petitioners also had the opportunity to question the person who prepared the 1992 documents memorializing the assignment of the MONOPOLOWA trademark to Mutual. *Id.* at ¶8

In February, 2013, Petitioners served on Respondent a Second set of Interrogatories and a Second Set of Requests for Production of Documents and Things. *Id.* at ¶9. None of the February 2013 Interrogatories or Requests for Production pertained to the 1992 transfer of the MONOPOLOWA trademark to Mutual. *Id.* at ¶10. Respondent notes that, although Petitioners did provide written responses to Respondent's Second Set of Requests for Production, no actual responsive documents have yet been provided by Petitioners. *Id.* at ¶12.

On March 18, Respondent filed its Motion for Summary Judgment, seeking dismissal of the instant cancellation proceeding as a matter of law based on the contractual agreement between the parties which transferred ownership of the MONOPOLOWA trademark from Petitioners to Respondent's predecessor in interest and title. In addition, Respondent filed a Motion to Suspend all proceedings in the instant action unrelated to such Summary Judgment motion.

On March 25, Petitioners filed their opposition to Respondent's Motion to Suspend, alleging, *inter alia*, that Respondent lacked good cause, and was attempting to avoid (or delay) discovery in this proceeding. Petitioners additionally argue that they may be forced to move under Rule 56(d) for further discovery "in order to obtain facts necessary to oppose Respondent's motion for summary judgment."

It is Respondent's belief that none of the Interrogatory responses nor any documents or things produced in response to the Second Set of Requests for Production related to the 1992 transfer, or otherwise would be germane to the pending Motion for Summary Judgment. *Id.* at ¶11.

Further, as neither person involved in the 1992 conversation during which the agreement to transfer the MONOPOLOWA trademark to Mutual was concluded is now alive, *Id.* at ¶7, there are

no discovery tools by which Petitioners could acquire any additional discovery which is germane to the pending Motion for Summary Judgment.

II. ARGUMENT

Respondent has filed a Motion for Summary Judgment that would be, if granted, fully dispositive of the instant cancellation proceeding. Specifically, the Motion focuses on the 1992 transfer of rights in the United States from Petitioners to Mutual, Respondent's predecessor in interest and title in and to the MONOPOLOWA trademark and the Registration for which cancellation is sought.

As is clearly stated in 37 C.F.R. §2.127(d):

When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

As a result, the Board will generally issue an order suspending proceedings when a party files a motion for summary judgment with respect to all matters not germane to that motion. See TBMP §528.03. However, because the suspension is not automatic, Respondent filed the instant Motion to Suspend on March 18, 2013 in order to insure the necessary suspension of this proceeding.

to avoid the requests that the Board suspend all proceedings unrelated to Respondent's Motion for Summary Judgment filed March 18, 2013, pending disposition of such motion.

Despite the protestations of Petitioners, the parties have to date undertaken and completed substantial discovery activities in this proceeding since its inception. In particular, Petitioners have obtained from both Respondent and Mutual more than seven thousand documents, including all responsive documents concerning the 1992 transfer of the MONOPOLOWA trademark. In addition, Petitioners have taken three discovery depositions, including that of Mickey Beckenfeld,

the only person alive at the start of this proceeding in 2008 who possessed first hand knowledge of that 1992 transfer. Petitioners' asserted concerns that they will be disadvantaged in responding to the Motion for Summary Judgment, and therefore may be forced to move for further discovery, is simply not supported by the facts in this proceeding. As noted above, none of the discovery requests in Petitioners' Second Set of Interrogatories or its Second Set of Requests for Production relate to the 1992 transfer of the MONOPOLOWA trademark. In addition, the prior discovery efforts of Petitioners has thoroughly mined this issue.

Further, to the extent any other documents relating to the 1992 transfer have not been produced by Respondent (or Mutual), they have nevertheless been requested, and the ongoing obligation of the parties to supplement their responses would suffice to ensure the production of the same. Petitioners can make no reasonable argument whereby they may say that any of the outstanding discovery responses would be germane to the pending Motion for Summary Judgment,

As noted above, given Petitioners' extensive discovery activities in this matter's inception, including three discovery depositions and extensive document production by both parties, compelling Respondent to respond to the current sets of discovery is wasteful, particularly in light of the filing of the potentially dispositive motion for summary judgment, and that any outstanding requests have no bearing on the 1992 transfer which is the subject of the Summary Judgment Motion.

Respectfully submitted,

Dated: April 1, 2013

By: 

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ALTVATER GESSLER – J.A. BACZEWSKI	:	Cancellation 92048732
INTERNATIONAL (USA) INC. and ALTVATER	:	
GESSLER – J.A. BACZEWSKI GMBH,	:	
	:	
Petitioners,	:	Registration No.: 2,731,948
	:	
v.	:	
	:	
RONALD BECKENFELD,	:	
	:	
Respondent	:	Attorney Docket No. B1001-9001

DECLARATION OF MICHAEL L. LOVITZ

I, Michael L. Lovitz, hereby state as follows:

1. This declaration is made in support of Respondent’s Reply in Support of Motion to Suspend in the above-captioned matter.

2. I am a partner in the law firm of Lovitz IP Law PC, which firm had served as legal counsel to Respondent in this matter since June 2010. Prior to June 2010, I also represented Respondent in this matter as a partner in the firm of Connolly Bove Lodge and Hutz, LLP from February 2008 until April 2009, and then as a partner Buchalter Nemer, from May 2009 until June 2010.

3. Petitioners first began their discovery efforts in June, 2008, serving Petitioners’ First Set of Interrogatories and First Set of Requests for the Production of Documents and Things on Respondent. These documents contained ten (10) numbered Interrogatories, and thirty-eight (38) numbered Requests for Production.

4. In November 2009, Petitioners served on Mutual Wholesale Liquor, Respondent’s predecessor-in-interest to the Registration that is the subject of this proceeding (“Mutual”) a Subpoena to Produce Documents, Information, or Objects. The Subpoena contained one hundred

twenty-to (122) numbered requests for Documents to be Produced Pursuant to Subpoena, and resulted in the production of 7,300 pages of documents.

5. During the course of discovery in the above-captioned matter, Petitioners have deposed Mickey Beckenfeld, the then-president of Mutual, on May 8, 2008, Respondent Ronald Beckenfeld on August 4, 2011, and John Wilson, the former General Manager of Mutual, on November 18, 2011.

6. During each of these depositions, counsel for Petitioners questioned the deponents in detail concerning the 1992 assignment of the MONOPOLOWA trademark.

7. On information and belief, both persons present for the 1992 conversation during which an agreement was finalized involving the transfer of the MONOPOLOWA trademark to Mutual are deceased.

8. During the Wilson deposition, counsel for Petitioners questioned the deponent concerning the fact that Mr. Wilson prepared the 1992 documents memorializing the assignment of the MONOPOLOWA trademark to Mutual, and the events surrounding the same.

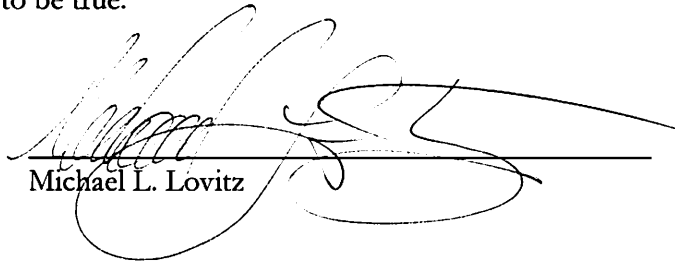
9. In February, 2013, both parties served their final written discovery requests on each other. Petitioners filed their Second Set of Interrogatories to Respondent, their Second Set of Requests for the Production of Documents and Things, and their First Set of Requests for Admissions to Respondent. Respondent has served its answers to the First Set of Requests for Admissions.

10. None of these February 2013 Requests for Production or Interrogatories are directed to the 1992 transfer of the MONOPOLOWA trademark.

11. On information and belief, no response to any of the unanswered pending discovery requests would have any bearing on the issue of the 1992 transfer of the MONOPOLOWA trademark to Mutual.

12. Although Petitioners did serve written answers to Respondent's Second Set of Requests for Production, no actual documents have yet been provided to Respondent by Petitioners.

The undersigned, being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declare that I am properly authorized to execute this document on behalf of the Respondent; that all statements made of my own knowledge are true; and all statements made on information and belief are believed to be true.

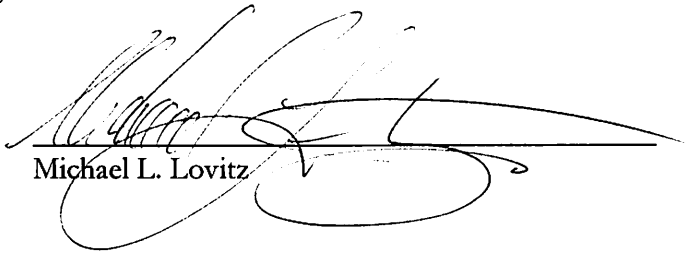


Michael L. Lovitz

CERTIFICATE OF SERVICE

I, Michael L. Lovitz, hereby certify on this 1st day of April, 2013, that a true and correct copy of RESPONDENT'S REPLY IN SUPPORT OF MOTION TO SUSPEND was served upon correspondent of record by first class mail, postage prepaid at the following address:

Peter S. Sloane
Leason Ellis LLP
One Barker Avenue, Fifth Floor
White Plains, NY 10601


Michael L. Lovitz